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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,536	01/25/2001	Manfred Tasto	P01,0005	9603
29177	7590	03/15/2004	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			D AGOSTA, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2683	8

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,536

Applicant(s)

TASTO, MANFRED

Examiner

Stephen M. D'Agosta

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Preliminary Amendment

The preliminary amendment dated 1-25-01 has been entered into the case of record.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Drawings

The drawings/drawing correction were received on 1-25-01 and were reviewed by the draftsman and examiner.

Claim Objections

Claim 1 objected to because of the following informalities:

- a. The examiner is confused by the statement "designating the BTS as a subscriber in the mobile radio network". The examiner believes it should state that the MOBILE is the subscriber and has interpreted the claim that way. Clarification is required.
- b. The examiner is confused by the statement "reactivating the radio cell when the second message is received". The examiner believes it should state that the MOBILE is reactivated. Clarification is required.

In both cases, it appears that the MOBILE is affected while the BTS continues to operate in normal mode. Appropriate correction is required. Failure to fix the claim will result in a USC 112 rejection.

Art Unit: 2683

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(Claims 1-10 were cancelled by the applicant and new claims 11-25 were added).

Claims 11 and 16-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Oura US 5,991,614.

As per **claim 11**, Oura teaches a method (figures 3-4 and C4, L32 to C5, L43) for operating a mobile communication device in a public cellular network having plurality of radio cells, at least one BTS and one mobile station (abstract and C1, L5-40 and C3, L44-64), comprising:

Designating the BTS MOBILE as a subscriber in the mobile radio network (C3, L65 C4, L15)

Logging the mobile station off from the BTS station when a first message from a locally emitting transmitter of small capacity is received (C4, L16-50 teaches RF control message/signal sent to phone)

In a radio cell, selecting on of: deactivating the mobile, stopping the mobile station, or passing the mobile station over either into an inactive call-blocked mode or into a mode that is blocked for outgoing calls and (C4, L51 to C5, L35 teaches RF control message/signal sent to phone for "power cutoff" or "transmission inhibit" circuit activated),

Art Unit: 2683

Reactivating the radio cell when a second message is received from the locally emitting transmitter (C5, L36-42, which teaches "resetting" of circuits afterwards which the examiner interprets as a control signal sent to turn-on the phone again).

As per **claim 16**, Oura teaches claim 11 wherein a mobile telephone is a subscriber in the radio network (abstract and figure 1b, #5).

As per **claim 17**, Oura teaches a system (figure 1a-2) for operating a mobile communication device in a public cellular network having at least one BTS and one mobile (abstract and C1, L5-40 and C3, L44-64), comprising,

the mobile having a transmitter/receiver assembly (figure 4, #5 phone has an antenna), microcontroller (#17 and #21), current supply unit (#18 and #20) and input/output assemblies (keypad on phone #5 and/or mouth/ear piece),

the transmitter-receiver assembly including a picocell radio device for receiving and evaluating specified messages and sending said messages to the microcontroller to initiate the microcontroller to transmit a network logoff signal via the transmitter/receiver (C4, L16-50 teaches RF control message/signal sent to phone)

whereby the microcontroller initiates the deactivation of the part of the transmitter/receiver required for communicating with the BTS (C4, L51 to C5, I35 teaches RF control message/signal sent to phone for "power cutoff" or "transmission inhibit" circuit activated).

As per **claim 18**, Oura teaches claim 17 wherein a mobile telephone is a subscriber in the radio network (abstract and figure 1b, #5).

As per **claim 19**, Oura teaches a system (figure 1a-2) for operating a mobile communication device in a public cellular network having at least one BTS and one mobile (abstract and C1, L5-40 and C3, L44-64),

a pico cell transmitter fixed station is arranged in access areas or at locations (figure 1b, #6 and 7);

Art Unit: 2683

where, with regard to the radio cell, active sending mobile stations or the use of such mobile stations is inadmissible or undesired (figure 1 shows protected area #1, C1, L5-15 and C2, L57-65),

so that specified messages are emitted in order to automatically deactivate and reactivate the mobile stations situated in the transmission range (C4, L51 to C5, l35 teaches RF control message/signal sent to phone for "power cutoff" or "transmission inhibit" circuit activated AND C5, L36-42, which teaches "resetting" of circuits afterwards which the examiner interprets as a control signal sent to turn-on the phone again).

As per **claim 20**, Oura teaches claim 19 wherein the picocell transmitter fixed station of small capacity is disposed in doorways or on aircraft runways (C1, L5-17 teaches airplane, hospital and public places which can placed in doorways, rooms, etc.).

As per **claim 21**, Oura teaches claim 20 wherein a picocell radio system is used for the picocell transmitter fixed station and for the corresponding radio device in the mobile telephone (C3, L12-14 – same frequencies as that used by the BTS).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oura and further in view of Alperovich US 6,233,448.

As per **claim 12**, Oura teaches claim 11 **but is silent on** further comprising the step of manually activating and logging the mobile station onto the mobile radio network

Art Unit: 2683

given a lack of a second message when the transmission range of the locally emitting transmitter is exceeded.

The examiner notes that a user attempting to make a call (based on Oura's system) will ultimately determine that they are in an area of denied service and must relocate in order for their phone to work. Oura teaches "resetting" of circuits after moving from the area whereby "the phone returns to ordinary operation" (C5, L35-42). The examiner interprets that this step can be both automatic and manual since a user can either wait for the system to turn the phone back on OR the user can walk outside the denied service area and manually attempt to turn on the phone until they are clear of said denied service area and communication is restored.

Alperovich teaches a system that activates/deactivates a mobile device based upon the position/location of said device (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Oura, such that the mobile is manually logged onto the network when the picocell transmission range is exceeded, to provide means for the user to reactivate the phone when out of denied service area.

As per **claim 13**, Oura teaches claim 11 **but is silent on** further comprising the step of automatically passing the mobile station over to an active mode and accepting standby operation when the second message is not received after a prescribable time interval.

Oura teaches "resetting" of circuits after the user moves from the area of denied service which is interpreted as reading on the claim since one skilled in the art would provide for a system that periodically checks that the user is still inside an area of denied service.

Alperovich teaches a system that automatically activates/deactivates a mobile device based upon the position/location of said device (abstract). This system periodically checks the location of the user.

It would have been obvious to one skilled in the art at the time of the invention to modify Oura, such that the mobile is passed over to active mode and accepting standby

Art Unit: 2683

operations when second message is not received after some time, to provide means for the unit to automatically comeback online after a certain amount of time has passed whereby the user may have moved outside the denied service area zone.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oura in view of Alperovich and further in view of Takemura EP0830046.

As per **claim 14**, Oura in view of Alperovich teaches claim 13 **but is silent on** further comprising the step of displaying the message content and/or a message parameter.

Takemura teaches transmission restriction of a mobile phone (title) whereby the mobile displays an indication for notifying that is has been placed in disabled mode (C4, L33-43).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination of Oura and Alperovich, such that a message or message parameter is displayed, to provide means for the user to be able to read a message stating service is denied.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oura in view of Alperovich and Takemura and further in view of Davis et al. US 6,314,519.

As per **claim 15**, Oura in view of Alperovich and Takemura teaches claim 14 **but is silent on** further comprising the step of signaling reception of either the first message or the second message by one of optical or acoustic means.

Davis teaches A fourth aspect of the invention involves the subscriber unit or pager being equipped with a primary and possibly a secondary apparatus for communicating both inbound and outbound messages. The primary apparatus comprises a conventional radio frequency receiver and optionally a conventional radio frequency transmitter. The secondary apparatus comprises an optical receiver and optionally an optical transmitter. Alternatively, the secondary apparatus may further comprise one or more acoustic or other electromagnetic transducers and associated

Art Unit: 2683

circuitry implementing a uni- or bi-directional communication link between the subscriber unit or pager and the originator (C2, L32-42).

It would have been obvious to one skilled in the art at the time of the invention to modify the combination of Oura, Alperovich and Takemura, such that optical or acoustic means are used, to provide for multiple communication technologies to be used between BTS, picocell and mobile.

Claims 22-23 rejected under 35 U.S.C. 103(a) as being unpatentable over Oura and further in view of Mousseau et al. 2002/0194285 (CIP date is 5-29-98) and Matero US 5,974,305.

As per **claim 22**, Oura teaches claim 21 wherein the picocell radio system is a DECT Standard or blue-tooth standard.

Mousseau teaches redirecting user-selected messages such as e-mail messages, calendar events, meeting notifications, address entries, alarms, warnings, stock quotes, news bulletins, journal entries and personal reminders, including attachments such as word processing document, video and audio clips, from host system such as user's desktop system and network server to Bluetooth enabled mobile communication devices such as mobile telephone, wirelessly enabled laptop and palmtop computers and handheld two-way wireless paging computer through LAN, WAN, Internet, wireless, cable TV and satellite networks (page 10, claim 6). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Oura, such that Bluetooth is used, to provide RF wireless support between devices using an industry-wide standard.

For DECT, Matero discloses support for dual mode operation, i.e., digital TDMA and analog FM, also referred to as DAMPS. In an article entitled "GSM and DECT-A Dual Mode Solution", Mobile Communications International Apr. 21, 1995, pgs. 57-60, B. Rashidzadel et al. describe an RF subsystem in FIG. 3 for a dual mode handset that operates in the GSM frequency band (890-960 MHz) and the DECT frequency band (1880-1900 MHz) [C1, L10-50]. It would have been obvious to one skilled in the art at

Art Unit: 2683

the time of the invention to modify Oura in combination with Matero, such that DECT communications is supported, to provide means for multiple standards to be used for communications between BTS, picocell and mobile.

As per **claim 23**, Oura in view of Mousseau and Matero teaches claim 22 wherein a mobile telephone is a subscriber in the radio network (abstract and figure 1b, #5).

Claims 24-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Oura and further in view of Matero.

As per **claims 24-25**, Oura teaches claim 23/24 **but is silent on** wherein the mobile phone is a dual-mode phone or DECT/GSM phone.

Matero teaches in the United States of America there is presently at least one system which supports dual mode operation, i.e., digital TDMA and analog FM, also referred to as DAMPS. As the systems such as GSM, PCS, DECT, DCS1800 and TDMA1900 become more widely used there is expected to be a need to have mobile stations which support two modes of operation, such as GSM and DCS1800 or DAMPS and TDMA1900 or DCS1900. A proposed third generation mobile telecommunication systems, such as UMTS (in ETSI) or FPLMTS (in CCIR), is under development. These advanced systems may also require some type of dual mode operation. In an article entitled "GSM and DECT-A Dual Mode Solution", Mobile Communications International Apr. 21, 1995, pgs. 57-60, B. Rashidzadel et al. describe an RF subsystem in FIG. 3 for a dual mode handset that operates in the GSM frequency band (890-960 MHz) and the DECT frequency band (1880-1900 MHz). In the transmitter portion a single I/Q modulator provides direct modulation at either the DECT or GSM frequency bands, and is connected through a SPDT switch to one of a DECT or a GSM transmitter chain. In the receiver portion separate DECT and GSM low noise amplifiers (LNAs) are used due to the large difference in frequencies (C1, L10-50).

Art Unit: 2683

It would have been obvious to one skilled in the art at the time of the invention to modify Oura, such that DECT/GSM is supported, to provide means for multiple standards to be used for communication between BTS, picocell and mobile.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Sagers et al. US 5,442,805
2. Isberg et al. US 6,246,891
3. Steer et al. US 6,343,213
4. Heinonen et al. US 6,438,385

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SMD
3-10-04

